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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,945	09/12/2003	Erik P. Staats	APPL-P2829COA	6999

28661   7590   10/20/2006

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/660,945	STAATS, ERIK P.
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 August 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1-5 and 11-13*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*1-5 and 11-13*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/04</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the amendment filed on 8/8/2006.

This action is made Final.

2.   In the amendment, claims 6-10 have been canceled. Claims 1-5, and 11-13 are pending in

the case. Claims 1, and 11 are independent claims.

Priority

3.   This application is a continuation of co-pending United States Patent Application Serial

Number **09/429,233, filed October 28, 1999**.

Information Disclosure Statement

4.   The IDS filed on 6/14/2004 has been accepted, and considered by the Examiner.

Drawings

5.   The drawings filed on 9/12/2003 have been accepted by the Examiner.

Specification

6.   The disclosure is still objected to because of the following informalities: Please update

the patent number of parent application **09/429,233 (parag. 0001)**.

Appropriate correction is required.

Double Patenting

7.   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

8.   Claims 11-13 remain rejected under 35 U.S.C. 101 as claiming the same invention as that

of claims 10, (11 and 13), and 12 of prior **U.S. Patent No. 6,691,096 B1, hereinafter 096**. This

is a double patenting rejection.

9.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10.　　　Claims 1-5, and 11-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 1, 9-10, (11 and 13), and 12 respectively of **U.S. Patent No. 6,691,096 B1, hereinafter 096** in view of Looney (Pat.# 6,232,539 B1, 5/15/2001, continuation filed on 6/17/1998).

Regarding claim 1, 096 teaches the limitations of these claims, except for *present the hierarchy to a device requesting data.* However, Looney discloses the display and organization of songs in a hard drive according to various categories. The categories further include subcategories, that in turn display various descriptive of the media data such as title, artist, date, etc. The categories and subcategories are displayed simultaneously on a gui (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17)-- *present* or display *the hierarchy to a*-- display-- *device requesting data.* It would have been obvious to one of ordinary skill in the art at the time of the invention to combine 096, and Looney, because of all the reasons found in Looney, including fully customizing music playback according to various parameters (col.1, lines 30-67), which would grant the user a more fulfilling and enjoyable listening experience.

This is a double patenting rejection.

Claim Rejections - 35 USC § 101

11.　　　35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 1-5, and 11-13

are rejected under 35 U.S.C. 101 because claims 1, and 11 are directed toward a computer

program product not embedded in a computer-readable medium. The product is non-functional

descriptive material. See MPEP 2105(a).

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 1-5, and 11-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by

Looney et al, hereinafter Looney (Pat.# 6,232,539 B1, 5/15/2001, continuation filed on

6/17/1998).

        Regarding independent claim 1, Looney discloses the display and organization of songs

in a hard drive according to various categories. The categories further include subcategories, that

in turn display various descriptive of the media data such as title, artist, date, etc. The categories

and subcategories are displayed simultaneously on a gui (col.2, lines 30-67, col. 9, line 48-

col.10, line 67, fig. 12-17)-- *compile a plurality of containers containing AV/C descriptor data;*

register one or more fields within each said container, and arrange said containers into a logical

hierarchy; present or display *the hierarchy to a--* display-- *device requesting data.*

Regarding claim 2, which depends on claim 1, Looney discloses the songs are stored

within the subcategories as mpeg3 files, having category flags appended to them. The files,

which are listed in various order, are played back to a user (col.2, lines 30-67, fig. 12-17)--

associating addresses with each of said fields sequentially enumerated within each of said

containers.

Regarding claim 3, which depends on claim 2, Looney discloses that the files are listed in

various orders, such as ascending, descending, etc (col.2, lines 30-67, col. 9, lines 1-67,

col.10,lines 30-67, fig. 12-17)-- *mapping said fields to a prescribed field list.*

Regarding claim 4, which depends on claim 3, Looney discloses the display of various

categories, such as title, artist, date, etc., which are listed individually from other categories

(col.2, lines 30-67, col.9, lines 48-col.10, line 67, fig. 12-17)-- *accessing any field within any*

container independently of any other container, and reading data from any field within any

container without affecting the access to any other container-- (col.2, lines 30-67, col. 9, line 48-

col.10, line 67, fig. 12-17).

Regarding claim 5, which depends on claim 4, Looney discloses the display of various

categories, such as title, artist, date, etc., which are listed individually from other categories

(col.2, lines 30-67, col.9, lines 48-col.10, line 67, fig. 12-17)-- *said plurality of containers comprise in combination an AV/C general object list descriptor.* (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17).

Regarding independent claim 11, Looney discloses the organization of songs in a hard drive according to various categories. The categories further include subcategories. The categories and subcategories are displayed simultaneously on a gui. The categories are displayed in a list according to a certain order, and category as result of a search of the songs in the containers. The song is played by the queuing of the song and setting a timer to 0. The user can then indicate the length of playtime of a song selected to be played (col.2, lines 30-67, col.9, line 1-col.10, col. 14, lines 37-50, col.10,lines 30-67, fig. 12-17, 27). In other words, a category listing is replaced with a newly selected category list as indicated by a user-- *identify a top level data container containing AV/C descriptor data; initialize compilation attributes; sequentially read the container data; and copy said read data into a readable buffer.*

Regarding claim 12, which depends on claim 11, Looney discloses the queuing of a song to be played and setting a timer to 0. The user can then indicate the length of play time of a song selected to be played (col.2, lines 30-67, col.9, lines 33-47, col. 14, lines 37-50, col.10,lines 30-67, fig. 27)-- *establishing a read buffer in a memory space and setting the read buffer offset to zero; establishing a received address request as a starting address, establishing a received read length request as a length sought.*

Regarding claim 13, which depends on claim 12, Looney discloses searching, and

displaying songs in the categories, and subcategories (col.2, lines 30-67, col.8, lines 58-col.9,

line 47, fig. 12)-- *the sequentially reading container data activity includes recursively searching*

for responsive data, said search initialized with said initialized attributes.

Response to Arguments

14.   Applicant's arguments filed on 8/8/2006 have been fully considered but they are not

persuasive. The Applicant indicates that Looney does not teach the hierarchical containers

containing AV/C descriptor (page 4). The Examiner disagrees, because Looney discloses the

display and organization of songs in a hard drive according to various categories. The categories

further include subcategories, that in turn display various descriptive of the media data such as

title, artist, date, etc.- *AV/C descriptor data.* The categories and subcategories--*hierarchy* --are

displayed simultaneously on a gui (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17)

Conclusion
15.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

I.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

(EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please

allow at least one business day.

Information regarding the status of an application may be obtained from the Patent

Application Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

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access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866

217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
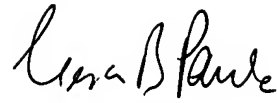P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:
- **(571)-273-8300** (for **all** Formal communications intended for entry)

Cesar B Paula 10/13/06

CESAR PAULA
PRIMARY EXAMINER